The Intersection of IT and Law

# The New E-Discovery Battle of the Forms

By Clinton P. Sanko and Cheryl Proctor

**Guidance on how to choose a production form that is efficient and effective.**

There are few easy answers in this new era of e-discovery under the *Federal Rules of Civil Procedure*. When you are "talking tech" and approaching e-discovery, universal rules have a strange way of being the wrong approach for the immediate problem. The strength of the new e-discovery rules lies in their flexibility. The rules allow lawyers to approach the issues of electronically stored information ("ESI") and decide, based on the needs of the case, how their clients will best be served. In other words, the new rules allow lawyers to be lawyers.

The flexibility of the new e-discovery rules is evident in the procedure of Rule 34(b), which allows the parties to choose the "form or forms" in which ESI will be produced. Fed. R. Civ. P. 34(b). This question of the "right" form for each case is a mixed bag that includes both issues that are within the province of Information Technology ("IT"), and issues that are questions of law. This article addresses Rule 34's permissiveness and provides some guidance on how to "lawyer" your way through this intersection of IT and law. The topics covered include: (1) an overview of the structure of Rule 34's battle of the forms; (2) a brief overview of the types of ESI production form; and (3) the considerations that should govern an analysis of which ESI production form best fits the needs of the case.

## Rule 34's E-discovery Battle of the Form (or Forms)

Rule 34 includes an e-discovery version of the traditional Uniform Commercial Code (UCC) "battle of the forms." In this e-discovery iteration, both the requesting party and the responding party have duties and, like the UCC, a misstep along the way can result in an ESI production form that is not ideal. A general overview of the new Rule 34 is included in the chart, "E-Discovery Battle of the Forms."

Broadly, in the Rule 34 document request, the requesting party "*may* specify *the form or forms* in which [ESI] is to be produced." Fed. R. Civ. P. 34(b) (emphasis added). The permissive language of

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Rule 34 recognizes that a particular form of ESI "may facilitate orderly, efficient, and cost-effective discovery." 2006 Advisory Committee Notes. Moreover, the Advisory Committee Notes make clear that "different forms of production may be appropriate for different types" of ESI. Therefore, the form of ESI is not a one-size-fits-all proposition. Rule 34(b)(iii), however, states that "a party need not produce *the same* [ESI] in more than one form," unless the parties agree or the Court orders it. Fed. R. Civ. P. 34(b)(iii) (emphasis added).

This article concentrates on the form of production that the requesting party "leads" with in the document request (the solid boxes in the chart of the *E-Discovery Battle of the Forms*). This lead triggers the Rule 34 battle of the forms. After the requesting party identifies a form of production, or chooses not to, the burden is shifted to the responding party, who must object or state the form the party intends to use.

## Learn to Trust the Techies

Under Rule 34's new structure, the initial request for production will require the lawyer to make an early and informed decision as to the form of production that may be appropriate for that particular case. In making this decision, the lawyer should consider consulting an IT-savvy e-discovery partner. Use of an e-discovery partner will vary depending on a number of factors. For example, the following should all be considerations impacting the use of an e-discovery partner: the internal resources of the law firm, the magnitude of the case (including the extent of the likely productions), budgetary constraints, and how technologically savvy and experienced the lawyers are that are involved.

This e-discovery partner can come from a variety of sources. Many firms have litigation support departments that spearhead the e-discovery efforts of the firm and bring a valuable perspective to the case. The litigation support department may also have relationships with outside e-vendors to be able to help steer lawyers in the right direction, if it is something they are unable to handle in-house. In firms without a litigation support department, lawyers may rely directly on outside e-vendors. Outside e-vendors include a wide-array of companies and individuals who can help litigators with a wide-variety of e-discovery issues, such as preservation, organization, forensics, review tools, etc. Many e-vendors also bring a breadth of e-discovery knowledge gleaned from their specialized experience.

Lawyers should not only be encouraged to trust the techies, but should do so early in the process. Oftentimes, lawyers wait until the production has been made and the discovery problem is fully formed before involving IT personnel. In that scenario, the IT personnel are reacting to problems and fashioning solutions. The better course is to involve an e-discovery partner early in an effort to avoid common e-discovery issues altogether. In cases where the IT personnel have not been included at an early stage, and are merely brought in to "fix" a problem, the costs tend to increase and a host of other issues may occur. These issues include making sure the in-house capabilities or vendor capabilities "match" with the form the parties have agreed upon.

## From Native to Paper and Everything in Between

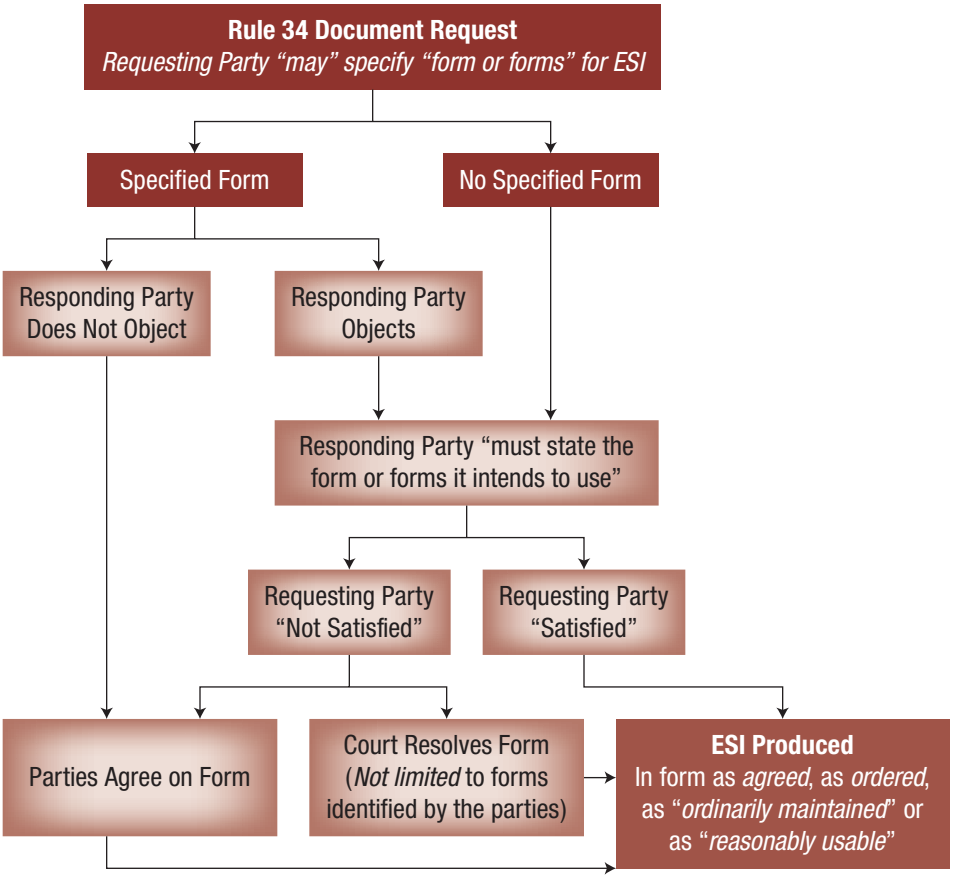
The lawyer must have at least a rudimentary understanding of the possible forms of ESI production to decide on the best form for the case, or even to converse intelligently with an e-discovery partner. This section broadly outlines the metadata issue and how it relates to ESI production "form," as well as defines the common e-discovery terms that are becoming a part of a litigators' general vocabulary.

### Metadata

The issue of metadata is not new to most of today's lawyers. Simply stated, "metadata" is "data about data." Metadata "includes all the contextual, processing, and use information needed to identify and certify the scope, authenticity, and integrity of active or archival electronic information or records." The Sedona Conference®, *The Sedona Guidelines: Best Practice Guidelines & Commentary for Managing Information and Records*

**E-Discovery Battle of the Forms**

Rule 34(b)'s procedure for production of Electronically Stored Information (ESI)



*in the Electronic Age* (The Sedona Conference Working Group Series, September 2005) (Appendix E: Technical Appendix), available at http://www.thesedonaconference.org. Metadata is data that is not necessarily seen by viewing the face of the document, but remains hidden within the electronic version. Most lawyers think of metadata in the context of native files. However, as discussed in more detail below, metadata is an issue that underlies the production of ESI regardless of the "form" identified.

Metadata can make a substantive difference in the right case. It is an issue to be aware of and addressed early. For instance, in *Plasse v. Tyco Electronics Corp.*, 448 F.Supp.2d 302 (D. Mass. Sept. 7, 2006), a former employee of Tyco (Plasse) was terminated. *Id.* at 303. In his later claim, a dispute developed about whether or not Plasse had misrepresented his credentials on the resume he submitted to Tyco. *Id.* at 304–305. After several discovery disputes, Tyco's computer expert was permitted to take a forensic image of Plasse's computer. *Id.* 306–308. The recovered resume showed that the plaintiff had attempted to alter the data: "File metadata (backup information about a file) revealed that the retrieved file was accessed and modified on June 28, 2005, then deleted at some unknown date between June 28, 2005, and the date on which the computer was produced, July 26, 2005." *Id.* at 306. The court found that "clear and convincing evidence demonstrates that plaintiff has engaged in extensive and egregious misconduct in this case," and concluded: "Plaintiff has destroyed or concealed evidence, engaging in an egregious pattern of misconduct that has hampered the proceedings in this case." Plasse's case was dismissed. *Id.* 308, 311. *Plasse* demonstrates that, in the right case, metadata can matter.

### Types of Productions

ESI production forms range from a request for the ESI in its "native" format, to an electronic image (such as a ".tiff" or ".pdf"), to documents being printed on paper and produced in boxes. Also, parties have the option to produce ESI to each other in online repositories, which are designed for review and production of ESI over the Internet or some other electronic medium. Each ESI production form has separate advantages and disadvantages, which are briefly discussed in this section. These advantages and disadvantages must factor into the calculus of what form is requested. Moreover, the lawyer must understand the basic differences between forms of production to make an informed choice from the varying options.

**Want to See Raw Metadata?**

Drag an email attachment to your desktop (work from a copy on your desktop to avoid losing anything). Right click on the file and click "rename" from the options. Change the .doc or .xls or other file identifier at the end of the filename to the following file extension:

**".txt"**

When you open the document in the notepad program, it shows you the raw code for the document, which includes the imbedded metadata.

***Native*** production format has received increased attention in current e-discovery cases. This production format simply refers to production of ESI in the file format in which it was created. Native format is as varied as the programs that create it and, by definition, describes ESI that was created within any number of programs, including commercially available and proprietary software.

Native file format productions are often associated with issues relating to metadata. The requesting party should be aware, however, that a request for native file format does not automatically mean that all metadata is included. If metadata is not discussed before the production, it is possible that the producing party may "scrub" (electronically remove) metadata from the file. This is demonstrated in the way that lawyers communicate with each other. Most lawyers remove metadata from electronic communications with someone outside their firm. To do this, lawyers use a metadata scrubber or other electronic tool. This metadata scrubber does not change the character of the email (it is still an email). Instead, the scrubber simply removes the underlying metadata from that email. As such, lawyers should remember to discuss and decide on how to approach issues of metadata as early as possible. *See* Guidelines for the United States District Court for the District of Kansas, Guidelines for Discovery of Electronically Stored Information (D. Kan. Oct. 17, 2006), available at http://www.ksd.uscourts.gov/guidelines/electronicdiscoveryguidelines.pdf ("The parties should discuss at the Fed. R. Civ. 26(f) conference whether 'embedded data' and 'metadata' exist, whether it will be requested or should be produced, and how to handle determinations regarding privilege or protection of trial preparation materials.").

***Image*** production differs from native in that image productions are merely pictures of the ESI. Image productions have two generally accepted formats, identified by the "file extension" or three letter extension to the right of the "dot" after the name of the file. These two generally accepted image productions are:

- a **.tiff** file, which is a tagged image file format or "**TIFF**"; and
- a **.pdf** file, which is a portable document format or "**PDF**".

To be useable, TIFF images have two critical electronic companions: (1) an index; and (2) optical character recognition (OCR). An index is necessary because TIFF files are often single pages. The index identifies where document breaks occur to allow the receiving party to navigate the production. Moreover, because a TIFF is a "picture," it is not automatically searchable. OCR simply means that a text version of the document accompanies the TIFF format, enabling the recipient to search the text of the document.

Metadata can also accompany the TIFF format. The tools used to convert a native file to a TIFF file can extract metadata fields and allow that metadata to be produced. As a result, the parties should agree to the production protocols relating to metadata before producing ESI. For instance, the parties could agree to a TIFF production, with negotiated metadata fields (*e.g.*, author, creation date, recipient, etc.). Alternatively, the parties could agree to produce in TIFF, with the producing party simply maintaining the metadata. Finally, a load file for a review tool should accompany this format. The load file simply has the electronic specifications for the program that will read the documents. It is a map of sorts, and allows whatever program being used by the receiving party to easily read and load the information received.

A PDF can be viewed and printed using free software. PDFs are saved as individual documents, obviating the need for the index. However, as was explained in regard to TIFF files, a useable PDF production is usually "searchable." The PDF is made searchable either by saving the file as searchable, or creating an OCR for the file when it is converted. Again, metadata must be discussed upfront to avoid it being lost by conversion and production in this format.

***Paper*** productions are also an option. While it may be surprising, some parties still choose a printed paper form. In a recent and seminal case addressing sanctions for failure to investigate the extent of ESI available, paper was the chosen form of production. *Phoenix Four, Inc. v. Strategic Resources Corp.*, Case No. 05 Civ. 4837, 2006 WL 1409413, *3 (S.D.N.Y. May 23, 2006). In that case, the responding party initially offered to produce certain late-discovered documents in a TIFF format, then offered to "provide the documents in an electronically searchable 'Case Vault' format," and finally agreed to provide the documents in hard copy (estimated to be 200–300 boxes of documents). *Id.*

## The Four Corners of Form

Rule 34 allows the requesting party to choose the "right" form of ESI from the various options. The choice of form should be guided by three primary considerations: (1) the substantive needs of the case; (2) the opposing party's ESI capabilities; and (3) the case management program that the lawyer intends to use to review the ESI. These three questions drive the form requested. While it is easy to request a form, and then rationalize the other questions, a systematic and thoughtful analysis on the front-end will result in a form that fits the case.

### Do You "Need" What You Are Asking For?

As far as is practicable, there should be a direct connection between the form of production requested and the substantive needs of the case. The type of proof, the elements of the claim, and the connection to the data requested will be critical in this analysis.

In e-discovery disputes, specificity is often more persuasive. This principle is demonstrated by the seminal case of *Williams v. Sprint/United Management Company*, 230 F.R.D. 640 (D. Kan. 2005). In *Williams*, Magistrate Judge Waxse ordered an employer defending an age discrimination claim in the context of a reduction-in-force ("RIF") to produce certain spreadsheets relating to the RIF. *Id.* at 642–644. When the RIF spreadsheets were produced, the requesting party complained that "prior to producing the electronic versions of the Excel spreadsheets, [the responding party] had utilized software to scrub the metadata." *Id.* at 644. Moreover, the responding party had "locked certain cells and data on the Excel spreadsheets prior to producing them so that [the requesting party] could not access those cells." *Id.* In other words, the requesting party complained that the spreadsheets were not produced in its unaltered native form (Microsoft Excel spreadsheets).

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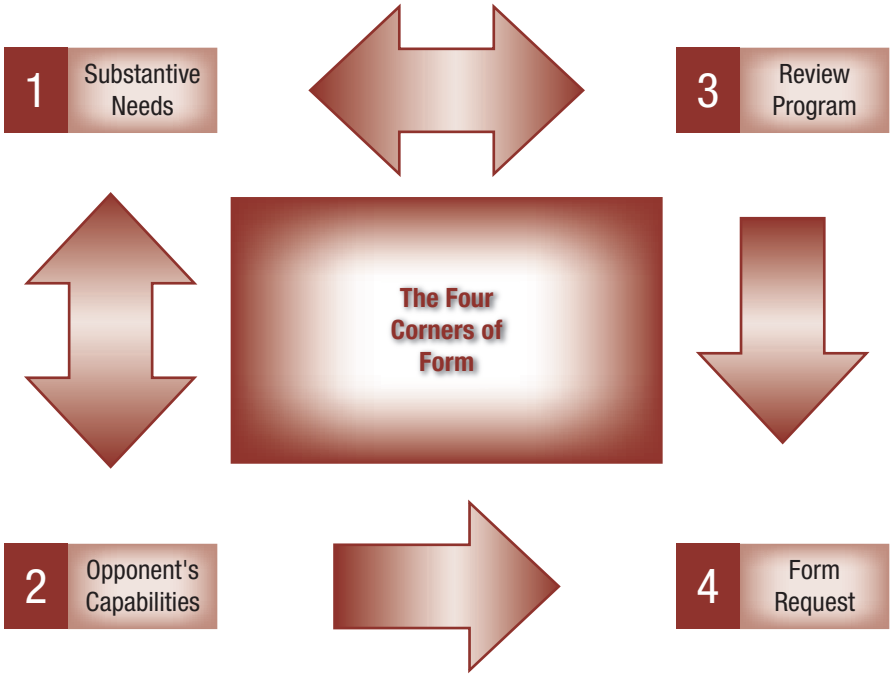
In ordering the native production, Magistrate Judge Waxse specifically noted that the requesting party (the Plaintiff) had *substantively explained* the need for the native form of production, with all attendant metadata:

> In light of the Plaintiffs' allegations that Defendant reworked pools of employees in order to improve distribution to pass its adverse impact analysis, the Court finds that some of the metadata is relevant and likely to lead to the discovery of admissible evidence.... The Court does find that metadata associated with any changes to the spreadsheets, the dates of any changes, the identification of the individuals making any changes, and other metadata from which Plaintiffs could determine the final versus draft version of the spreadsheets appear relevant.

*Id.* at 653. The Plaintiffs were able to provide the Court with the specific reasons that the unaltered native production was important to the facts of that case. As a result, the Plaintiffs were successful in their "form" request.

The lawyer making a Rule 34 form request should, if practical, know if and why the native form (with its attendant metadata) is needed for the case, or if some

**The Four Corners of Form**



other form of production will suffice. Some cases order production in the native format because the responding party is not specific enough in its objection. *See Nova Measuring Instruments Ltd. v. Nanometrics, Inc.*, 417 F.Supp.2d 1121, 1122–23 (N.D. Cal. 2006) (stating that the responding party "offers no reason why the documents should not be produced in their native format" and ordering that the documents "be produced in their native file format with original metadata"); *Treppel v. Biovail Corp.*, 233 F.R.D. 363, 374 (S.D.N.Y. 2006) (stating that plaintiff requested the documents in native form and ordering production in native form because while "Biovail objected to request, it has provided no substantive basis for its objection"); *In re NYSE Specialists Securities Litigation*, No. 03 Civ. 8246 (RWS), 2006 WL 1700447 (S.D.N.Y. June 14, 2006) (ordering without comment that "all electronic documents shall be produced in their native format" with metadata included). Others support a requirement that the requesting party articulate its need for the native format and the attendant metadata. *See Wyeth v. Impax Laboratories, Inc.*, No. Civ. A. 06-222-JJF, 2006 WL 3091331, *2 (D. Del. Oct. 26, 2006) (stating that the requesting party must "demonstrate a particularized need for the native format of an electronic document" to receive something other than an image file). In any event, the more specific a party can be in rationalizing its need for a certain form, the more persuasive the argument will be.

**In the e-discovery battle of the forms, specificity wins.**

### Can They Do What You Are Asking?

The requesting party also should be cognizant of the responding parties' e-capabilities in making the Rule 34 form request. The form included in the Rule 34 document request should rarely be a surprise to the responding party. The *Federal Rules of Civil Procedure* are designed so that the Rule 26(f) discovery-planning conference will precede any discovery requests. Other than certain specified exceptions "or by order or agreement of the parties, a party may not seek discovery from any source before the parties have conferred as required by Rule 26(f)." Fed. R. Civ. P. 26(d). Therefore, in the vast majority of federal cases, the parties will meet and confer at the 26(f) discovery planning conference prior to any e-discovery "form" being included in any document requests.

Under the new Rule 26(f), the parties are directed "to discuss discovery of electronically stored information during their discovery-planning conference." *Id.* at 26(f)(3) and (4), and 2006 Advisory Committee Notes. An article of equal or greater length could be devoted to the parties' respective Rule 26(f) duties as it relates to e-discovery. The Advisory Comments make it important for the lawyers, at a minimum, to have some understanding of the clients' IT systems:

> It may be important for the parties to discuss those [IT] systems, and accordingly important for counsel to become familiar with those systems before the conference. With that information, the parties can develop a discovery plan that *takes into account the capabilities of their computer systems*. In appropriate cases identification of, and early discovery from, individuals with special knowledge of a party's computer systems may be helpful. *Id.* at 2006 Advisory Committee Notes (emphasis added).

The more that parties are able to effectively communicate, the more likely it will be that the parties can agree on the front-end on the form of production. In this way, the "specified form" in the production request can reflect the agreement reached at the Rule 26(f) conference. At a minimum, the production form could reflect some understanding of the capabilities of the opponent's IT systems. Such communication can head off costly potential disputes.

Moreover, the Rule 26(f) conference is a means by which a requesting party can begin to ferret out when the party has an IT system that will require the responding party to "translate" the ESI into a "reasonably usable form." Fed. R. Civ. P. 34(a). If the responding party has a proprietary computer system and will have to produce the information in a form that is reasonably usable, the earlier the parties can discuss these issues, the more likely expensive and protracted discovery battles can be avoided. *See, e.g., Static Control Components, Inc. v. Lexmark Int'l, Inc.*, Court File No. Civ.A. 04-84-KSF, 2006 WL 897218, *4 (E.D. Ky. April 5, 2006) (stating that a responding party could not "hide behind its peculiar computer system as an excuse for not producing" responsive information).

The lawyer may be sufficiently educated about the opposing party's IT system at the Rule 26(f) conference and choose to not specify the form. Where the requesting party did not specify a form, the responding party may produce the information in the form in which it is "ordinarily maintained" or in a form that is "reasonably usable." However, the responding party may not engage in gamesmanship by degrading the form. (2006 Advisory Committee Notes; *see also* Fed. R. Civ. P. 34(b)(ii) ("If the responding party ordinarily maintains the information it is producing in a way that makes it searchable by electronic means, the information should not be produced in a form that removes or significantly degrades this feature.").) The requesting lawyer should know from the Rule 26(f) conference how that data is "ordinarily maintained" and whether it is a form that the requesting party can realistically use.

Also, while the rules specifically state that a party need not produce information in more than one form, the rules allow the parties to agree otherwise. Parties may agree at the Rule 26(f) conference to a protocol where documents are produced in a searchable TIFF format, with provisions for reasonable designation of specific documents that the requesting party believes, after an initial review, should be reproduced in native format. The Rule 26(f) conference is an opportunity to avoid expensive form questions. In *Ponca Tribe of Indians of Oklahoma v. Continental Carbon Co.*, No. CIV-05-445-C, 2006 WL 2927878, *2 (W.D. Okla. Oct. 11, 2006), the responding party chose to produce email by electronic email because the requesting party did not specify; the court denied the later motion to have the email reproduced in native form but noted that "the parties have agreed to produce

**Forms**, continued on page 83

**Forms**, from page 66
certain information in electronic form… [and] the Court's ruling has no impact on the parties' agreement…." *Id.*

The requesting party also has to be cognizant of the return volley when the responding party becomes the requesting party. While the system capabilities make it impossible to create a blanket rule, courts have been receptive to the objection that the party is asking for something it refused to do itself. For instance, in one case a party produced documents in an unsearchable TIFF format, and then complained when the opposing party produced the documents in that form. *OKI America, Inc. v. Advanced Micro Devices, Inc.*, Court File No. C 04-3171, 2006 WL 2547464, *4–5 (N.D. Cal. Aug. 31, 2006). The court denied a motion to compel a different production format because the requesting party was asking for something that party "itself refused to do." *Id.*

### Can You Use What You Are Getting?

There are various review tools that can be utilized to review the electronic data that is received in a case. These software solutions are like different models of a car. They all function for the same purpose (organization, review, production of documents), but they come in different makes, with different features, and with different price tags. Review tools have numerous capabilities and diverse strengths: handling more data; better coding features; cost; ease of use; and extranet or repository abilities allowing review over the Internet. The desired result is the same. The requesting party wants to obtain the data, review it, and use it to advance its interests in the lawsuit. The review tool can factor into your form request. It is advisable, for instance, to identify the load file for the program you are using in your form request. In this way, your opponent can give you data in the form in which it is easiest to access.

### Is the Form a Natural Extension of the First Three Answers?

The answer to the "form" request now permitted by Rule 34 depends on your case; it depends on your opponent; and it depends on your technology. Many lawyers seem to believe that the native form is the simplest and most attractive option, and gives you the most "complete" data set because it is usually accompanied by metadata. There are instances, however, where costs are incurred, and extra time spent, converting the file formats so that they can be loaded into a review tool, since some review tools do not accept native format. Some files are more manageable in native format, and intended for that medium. Spreadsheets, for example, do not work well in converted form. When spreadsheets are converted to TIFFs or PDFs, formulas and other data are not carried over. If the case is spreadsheet intensive, it is advisable to request those files in their native form, with metadata and all formulas. Other documents can be produced in TIFF format.

The most common and accepted format currently used is TIFF, with an index, OCR, negotiated metadata, and review tool load file. This format is easy to manage, as long as its electronic companions (index and OCR) are included. Moreover, the review tool should be identified and the load file specifications provided to the responding party. If the OCR is of reasonably good quality, and the files are given in an organized fashion with clear document breaks, this production is easier to manage than many of the alternatives.

## Conclusion

Litigators are familiar with the shades of gray that exist in a lawsuit and e-discovery is no different. No concrete advice can be given as to the "right" form for every case. This explains the flexibility of the new *Federal Rules of Civil Procedure*. This flexibility allows the parties to identify and agree on a form that both parties can use. Early involvement of an e-discovery partner, and a general familiarity with the new vocabulary of e-discovery, will be essential tools in the litigator's toolbox. As to what "form" should be used in the case, the attorney should consider the substantive needs of the case, the opponent's capabilities, and the review tool that will be used. Every case is different. FD